

REMARKS

In the Office Action, dated March 24, 2004, the Examiner has rejected claims 13-52. Reconsideration and allowance of pending claims 13-52 in view of the following remarks are respectfully requested.

A. Offer to Surrender

The assignee of record, PCTEL, Inc., makes this statement as part of the reissue application for reissue of letters patent number 5,864,714, titled "Communication System which Dynamically Switches Sizes of Sample Buffer between First Size for Quick Response Time and Second Size for Robustness to Interrupt Latency" granted on January 26, 1999, to Tal, et al. and declares that PCTEL, Inc., is now owner by assignment of the entire interest in said original patent and hereby offers to surrender U.S. Patent No. 5,864,714 effective upon the issuance of the instant reissue application.

B. Rejection of Claims 13-52 Under 35 U.S.C. § 251

The Examiner has rejected 13, 15, 27-29, 39-41 and 51-52, under 35 U.S.C. § 251, as being an improper recapture of broadened claims subject matter in the application for the patent upon which the present reissue is based. Applicant respectfully disagrees.

The Examiner states that "As indicated by Applicant, claims 13, 15, 27-29, 39-41 and 51-52 are substantially similar to claims 1, 6 and 11, however, claims 13, 15, 27-29, 39-41 and 51-52 have been changed to broaden the claims subject matter." Further, the Examiner states that "Claims 13, 15, 27, 29, 39, 41 and 51, do not recite, 'when it is desired to optimize said

communications system”, and “Claims 28, 40 and 52 recite, “a sample buffer that is variable in size”, while the similar limitation in the original claim 6 recites, ‘sample buffers having a first buffer size ... sample buffers having a second buffer size.’” The Examiner states that the omission of “when it is desired to optimize said communications system” broadens the claimed subject matter, and it is clear that the term “variable size” is broader than the term “first buffer size and second buffer size.”

First, it is respectfully submitted that 35 U.S.C. § 251 indeed permits a reissued patent to enlarge the scope of the claims of the original patent if applied for within two years from the grant of the original patent. Accordingly, claims of a reissue patent application cannot be rejected merely because they enlarge the scope of the claims in the original patent.

Furthermore, as stated by the Federal Circuit, the recapture rule “prevents a patentee from regaining through reissue the subject matter that he surrendered in an effort to obtain allowance of the original claims.” Pannu, et. al. v. Storz Instruments, Inc., 258 F.3d 1366, 1371-72 (Fed. Cir. 2001), citing In re Clement, 131 F.3d 1464, 1468 (Fed. Cir. 1997) (emphasis added.) Stated differently, “Reissued claims that are broader than the original patent's claims in a manner directly pertinent to the subject matter surrendered during prosecution are impermissible.” Id. (emphasis added.) As explained by the Federal Circuit, application of the recapture rule is a three-step process, as follows:

The first step is to “determine whether and in what 'aspect' the reissue claims are broader than the patent claims.” Id. “The second step is to determine whether the broader aspects of the reissued claim related to surrendered subject matter.” Id. Finally, the court must determine whether the reissued claims were materially narrowed in other respects to avoid the recapture rule. Id.

“To determine whether an applicant surrendered particular subject matter, we look to the prosecution history for *arguments* and changes to the claims made in an effort to overcome a prior art rejection.” *In re Clement*, at 1468.

During the prosecution of U.S. Patent No. 5,864,714 (the “714 patent”), in response to the Examiner’s rejection in the office action, dated October 6, 1997, applicant made the following amendment to claim 1:

1. A method, in a communications system, of achieving a balance between processing response time, on one hand, and robustness to interrupt latency and processor implementation overhead, on the other hand, said method comprising of the steps of:

utilizing [data] sample buffers having a first buffer size when it is desired to optimize said communication system so as to have quick processing response times[, and] :

utilizing [data] sample buffers having a second buffer size when it is desired to optimize said communication system so as to be robust to interrupt latency and to have low processor implementation overhead[.] : and

providing switching means enabling said communication system to dynamically switch between using said buffers having a first buffer size and said buffers having a second buffer size.

Further, claim 10 was also amended in a similar fashion, and new claim 16 was added which included an element similar to the providing step of claim 1. Also, applicant argued that the cited references “each fail to disclose the step of providing switching means enabling the communication system to switch the size of sample buffers being used from a first buffer size to a second buffer size and vice versa.” (Response to Office Action, dated October 6, 1997, page 6, lines 10-13.)

It is respectfully submitted that the words “when it is desired to optimize said communications system” were in claim 1, as originally submitted, and were not added to claim 1 in order to distinguish claim 1 over the cited references. Furthermore, applicant did not distinguish claim 1 over the cited references by relying upon the words “when it is desired to optimize said communications system.” Accordingly, applicant respectfully submits that at least the second step of the recapture rule is not met, because the broader aspects of claims 13, 15, 27-29, 39-41 and 51-52 do not relate to any surrendered subject matter.

In fact, an element similar to the step of “providing switching means enabling said communication system to dynamically switch between using said buffers having a first buffer size and said buffers having a second buffer size”, which was added by an amendment to claim 1 and argued as a distinguishing element over the cited references, still exists in each of the pending independent claims 13, 15, 27, 28, 29, 39, 40, 41, 51 and 52. For example, claim 13 recites: “employing a switching device enabling said communication system to dynamically switch between using said transmit and receive sample buffers having a size L1 and a size L2.”

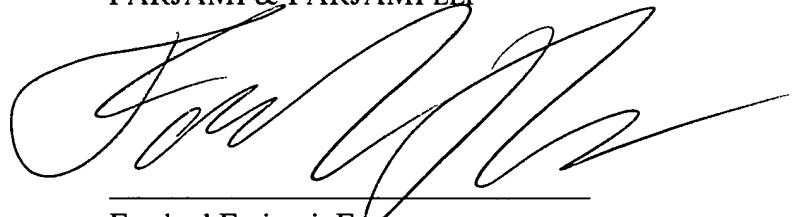
Furthermore, claims 28, 40 and 52 still include a first buffer size and a second buffer size, and applicant did not make any argument to distinguish claims of the ‘714 patent based on the sample buffers being or not being “variable in size”, and did not make any amendment to that effect in order to obtain allowance of the claims in the ‘714 patent. Accordingly, applicant respectfully submits that the limitation “a sample buffer that is variable in size” was not surrendered during the prosecution of the ‘714 patent and, thus, the second step of the recapture rule cannot be met.

Applicant respectfully submits that the first and third steps of the recapture rule do not need to be addressed at this point, since the second step of the recapture rule clearly fails to be met.

C. Conclusion

For all the foregoing reasons, an early allowance of claims 13-52 pending in the present application is respectfully requested. The Examiner is invited to contact the undersigned for any questions.

Respectfully Submitted;
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